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PATENT INFORMATION DIVISION

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OFFICE OF PETITIONS

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Docket Number 22097; CIP: 04

Mail to: Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Fax: (703) 308-6916

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703) 305-9282

Patent No. 5,700,654 Application Number 304,147  
Issue Date 12/23/97 Filing Date 9/12/94

CAUTION Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number (or reissue patent number, if a reissue) and (2) the application number of the actual U.S. application (or reissue application) leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

Also complete the following information, if applicable

The above-identified patent:

- ☐ is a reissue of original Patent No. \_\_\_\_\_, original issue date \_\_\_\_\_;  
original application number \_\_\_\_\_,  
original filing date \_\_\_\_\_.
- ☐ resulted from the entry into the U.S. under 35 U.S.C. 371 of international application  
\_\_\_\_\_ -filed on \_\_\_\_\_.

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CERTIFICATE OF MAILING (37 CFR 1.8(a))

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

9/7/04  
Date

Eric H. Kuhars  
Signature

Printed Name ERIC H. KUHARS

09/17/2004 DALLEN 00000032 5700654

01 FC:2551 455.00 OP  
02 FC:1599 1630.00 OP

Adjustment date: 10/24/2005 AKELLEY  
09/17/2004 DALLEN 00000032 5700654  
01 FC:2551 -455.00 OP  
02 FC:1599 -1630.00 OP  
Refund Ref:  
10/24/2005 AKELLEY 0000148301

CHECK Refund Total: \$2085.00

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1. SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27

2. LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g).

3. MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition, unless it was paid earlier.

NOT Small Entity			Small Entity		
Amount	Fee	(Code)	Amount	Fee	(Code)
<input type="checkbox"/> \$890.00	3 1/2 yr fee	(1551)	<input checked="" type="checkbox"/> \$445.00	3 1/2 yr fee	(2551)
<input type="checkbox"/> \$2,050.00	7 1/2 yr fee	(1552)	<input type="checkbox"/> \$1,025.00	7 1/2 yr fee	(2552)
<input type="checkbox"/> \$3,150.00	11 1/2 fee	(1553)	<input type="checkbox"/> \$1,575.00	11 1/2 fee	(2553)

MAINTENANCE FEE BEING SUBMITTED \$ 445.00

4. SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) of \$1,640.00 (fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

SURCHARGE BEING SUBMITTED \$1,640.00

5. MANNER OF PAYMENT

☒ Enclosed is a check for the sum of \$2,085.00.

☐ Please charge Deposit Account No. \_\_\_\_\_ in the sum of \$ \_\_\_\_\_. A duplicate copy of this authorization is attached.

☐ Payment by credit card. Form PTO-2038 is attached.

6. AUTHORIZATION TO CHARGE ANY FEE DEFICIENCY

☐ The Commissioner is hereby authorized to charge any maintenance fee, surcharge or petition deficiency to Deposit Account No. \_\_\_\_\_. A duplicate copy of this authorization is attached.

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7. OVERPAYMENT

As to any overpayment made please

☐ Credit to Deposit Account No. \_\_\_\_\_

OR

☒ Send refund check.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

8. STATEMENT

The delay in payment of the maintenance fee to this patent was unintentional.

9. PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED.

September 7, 2004  
Date

Eric H. Kuhrts  
Signature(s) of Petitioner(s)

707-876-9222  
Telephone Number

Eric H. Kuhrts  
President and CEO  
LIPOPROTEIN TECHNOLOGIES, INC.  
1109 Tannery Creek Rd.  
Bodega, CA 94922

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

ENCLOSURES:

- ☒ Maintenance Fee Payment
- ☒ Surcharge under 37 CFR 1.20(i)(2) (fee for filing the maintenance fee petition)
- ☒ Postcard

**LICENSE AGREEMENT**  
**between**  
**VANDERBILT UNIVERSITY**  
**and**  
**LIPOPROTEIN DIAGNOSTICS, INC.**

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**OFFICE OF PETITIONS**

THIS AGREEMENT, by and between VANDERBILT UNIVERSITY, a not-for-profit corporation, organized and existing under the laws of the state of Tennessee ("VANDERBILT"), and LIPOPROTEIN DIAGNOSTICS, INC., a corporation, having a principal place of business at Redwood City, California (the "LICENSEE") is effective as of the 15 day of May, 1998 (the "Effective Date").

**RECITALS**

WHEREAS, VANDERBILT holds title by assignment to the invention by L. Jackson Roberts and Jason D. Morrow named "METHOD AND COMPOSITIONS TO ASSESS OXIDATIVE STRESS IN VIVO (the "VANDERBILT Invention") and has all rights of the inventor to the VANDERBILT Invention and to any patents issued with respect to the VANDERBILT Invention and VANDERBILT is willing to grant a license to the VANDERBILT Invention and to any patents rights issued for said VANDERBILT Invention; and

WHEREAS, VANDERBILT and Oxford Biomedical Research, Inc. ("Oxford") jointly hold title by assignment to the invention by L. Jackson Roberts and Jason D. Morrow, employees of VANDERBILT and Denis M. Callewaert, employee of Oxford, named "METHOD FOR ASSESSMENT OF OXIDATIVE STRESS IN VIVO: IMMUNOASSAY TO MEASURE TOTAL ISOPROSTANES" (the "Joint Invention) and jointly have all rights of the inventors to the Joint Invention and to any patents issued with respect to the Joint Invention and VANDERBILT is willing to grant a license to VANDERBILT'S rights in the Joint Invention and to any patents rights issued for said Joint Invention; and

WHEREAS, LICENSEE desires to acquire, and VANDERBILT desires to grant to LICENSEE, a license to all intellectual property rights embodied in or derived from the VANDERBILT Invention and to VANDERBILT'S rights embodied in or derived from the Joint Invention in the field of clinical diagnosis, including the rights to make, use and sell "Licensed Products" and "Licensed Processes" as hereinafter defined, and to grant sublicenses upon the terms and conditions hereinafter set forth;

NOW, THEREFORE, in consideration of the mutual covenants and agreements herein contained, it is agreed by the parties as follows:

## 1 DEFINITIONS

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1.0 Licensed Patent Rights shall mean those "U.S. Patent Rights" arising from and existing by virtue of the operation of the Patent laws of the United States of America falling within the scope of one or more claims in (a) United States Patent 5,700,654, "Method and Compositions to Assess Oxidative Stress In Vivo"; (b) United States Continuation-In-Part Application Serial No. 08/912,440 based on United States Patent 5,700,654; (c ) United States Patent Application Serial No. 60/038496, "Method for Assessment of Oxidative Stress In Vivo: Immunoassay to Measure Total Isoprostanes"; and (c ) any divisions, continuations, extensions or reissues thereof.

1.1 Foreign Patent Rights shall mean those "Foreign Patent Rights" arising from and existing by virtue of the operation of the patent laws of a country other than the United States.

1.2 Licensed Product(s) shall mean products claimed in Patent Rights or products which are made in accordance with or by means of Licensed Processes or products made, at least in part, using VANDERBILT Technical Information.

1.3 Licensed Process(s) shall mean any process which is covered in whole or in part by an issued, unexpired claim or a pending claim contained in the Licensed Patent Rights or which utilizes VANDERBILT Technical Information.

1.4 Net Sales. The term "Net Sales" shall mean the receipts for Licensed Products or Licensed Processes sold by LICENSEE or sublicensee during the term of this agreement, computed quarter by quarter, less allowances for:

- (a) cash, trade, or quantity discounts,
- (b) taxes, including sales taxes and duties, and
- (c ) credits, returns and replacements.

Licensed Products or Licensed Processes shall be deemed sold when paid for, and shall include payments for lease or any other form of payment for use of Licensed Product.

1.5 The Inventors. The term "Inventors" shall mean the named inventors on the Patent Application set forth in Paragraph 1.0.

1.6 Technical Information shall mean all non-public research and development information, unpatented inventions, know-how, and technical data resulting from research under the direction of the Inventors on the effective date of this Agreement which is needed to produce Licensed Products, to practice Licensed Processes, or to exercise the Patent Rights licensed herein.

1.7 Fair Market Value means the cash consideration which LICENSEE or its sublicensee would realize from an unaffiliated, unrelated buyer in an arm's length sale of an identical item sold in the same quantity and at the same time and place of the transaction.

1.8 Affiliate means, when used with reference to LICENSEE, any entity directly or indirectly controlling, controlled by or under common control with LICENSEE. For purposes of this Agreement, "control" means the direct or indirect ownership of over fifty percent (50%) of the outstanding voting securities of an entity, or the right to receive over fifty percent (50%) of the profits or earnings of an entity, or the right to control the policy decisions of an entity.

## 2 GRANT

2.0 Exclusive License. VANDERBILT hereby grants to LICENSEE and LICENSEE hereby accepts from VANDERBILT, upon the terms and conditions herein specified, an exclusive, nontransferable, royalty bearing license under the U.S. Patent Rights and Foreign Patent Rights to make, use and sell Licensed Products and Licensed Processes in the field of clinical diagnostics and to grant sublicenses, subject to VANDERBILT's approval, which approval shall not be unreasonably withheld. In order to provide LICENSEE with a period of exclusivity, VANDERBILT agrees it will not grant licenses under Patent Rights to others except as required by VANDERBILT's obligations in paragraph 2.1 or as permitted in paragraph 2.2 and that it will not provide Licensed Products to others for any commercial purpose.

2.1 Federal Government Rights Reserved. Notwithstanding the exclusive license granted herein, the Federal Government shall receive all the rights to the VANDERBILT Invention and the Joint Invention (the "Inventions") required by law or regulation to be reserved to the government. The parties agree that the Federal Government is hereby granted a non-exclusive, non-transferable, irrevocable, royalty free license to practice or have practiced on its behalf throughout the world the Inventions. All rights granted in this Agreement are expressly granted subject to the rights of the Federal Government and such rights are specifically reserved to the Government by this Agreement.

2.2 Reservation of Rights. VANDERBILT reserves the right to make, use and further develop the Inventions for its own educational and research purposes and to grant to third parties licenses of rights to make, use and sell the Inventions for uses and in fields not expressly granted herein.

2.3 Due Diligence. In addition, LICENSEE shall adhere to the following milestones:

a. LICENSEE shall use reasonable efforts to make the Licensed Products and Licensed Processes known and available to the public, in the territories covered by the Licensed Patent Rights and granted hereunder, in reasonable quantities and for reasonable consideration, within a period of five (5) year(s) following the Effective Date of the present Agreement.

b. During such five (5)-year period, should LICENSEE not make the Licensed Products or Licensed Processes known and available to the public, in the territories covered by the Licensed Patent Rights and granted hereunder, in reasonable quantities and for reasonable consideration, LICENSEE shall have the right to petition VANDERBILT for an extension of

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such period. VANDERBILT shall not unreasonably reject such petition if the petition is supported by a substantial showing that LICENSEE has diligently used reasonable efforts to make the Licensed Products and Licensed Processes available to the public. Should such showing not be made to VANDERBILT's satisfaction, VANDERBILT shall have the right, in its sole discretion, to modify or terminate the present Agreement.

c. After making any Licensed Product or Licensed Process available to the public, LICENSEE shall continue to make such Licensed Product or Licensed Process available to the public at reasonable cost for the term of the present Agreement. If at any time LICENSEE shall not make such Licensed Product or Licensed Process reasonably available to the public, LICENSEE shall promptly notify VANDERBILT, and VANDERBILT shall have the right, in its sole discretion, to modify or terminate the present Agreement.

2.4 Licensing and Sublicensing by LICENSEE. LICENSEE has the right to grant royalty bearing sublicenses to independent third parties. LICENSEE agrees to give VANDERBILT reasonable notice of LICENSEE's intent to grant any such sublicense, including the proposed terms thereof. All sublicenses shall bind the sublicensee to meet LICENSEE's obligations to VANDERBILT under this Agreement. Copies of all sublicense agreements shall be provided to VANDERBILT.

2.5 Subsidiaries and Distributors. License rights granted hereunder shall enable LICENSEE to make, use, sell or otherwise distribute Licensed Products or Licensed Processes through any of its subsidiaries and to sell Licensed Products or Licensed Processes through any of its normal channels including its subsidiaries, distributors, and agents. LICENSEE ensures that Licensed Products and any products embodying the subject invention or produced through the subject invention for sale in the United States shall be manufactured substantially in the United States or its territories.

2.6 LICENSEE agrees to supply the laboratory of the Inventors at VANDERBILT at no charge quantities of Licensed Products, not to exceed one hundred (100) kits or units per year, that LICENSEE offers for sale or otherwise makes available for public use.

### 3 TERMS AND TERMINATION

3.0 Term. Unless previously terminated as herein provided, this Agreement shall become effective as stated above and shall continue or be renewed until the last to expire of the Licensed Patents in any country in which a Patent may have issued. LICENSEE shall not be required to pay royalties by reason of the manufacture, use or sale of a product after the Licensed Patent has expired.

3.1 Termination. This Agreement may be terminated by written notice to the other party:

(a) Other than as stated in Article 3.1(b), in the event that one party commits any

substantial breach of this Agreement, the non-breaching party at its option, may terminate this Agreement by giving the breaching party written notice of its election to terminate as of a stated date, not less than forty-five (45) days from the date of the notice. Such notice shall state the nature of the defaults claimed by the non-breaching party. The breaching party during said forty-five (45) day period, or such longer period as may be indicated by the other, may correct any default stated in said notice and if such default is corrected to the satisfaction of the non-breaching party, this Agreement shall continue in full force and effect as if such notice had not been given. Failure by LICENSEE to pay earned or annual minimum royalties to VANDERBILT in a timely manner shall be deemed a substantial breach of the Agreement.

(b) In the event LICENSEE shall become insolvent or shall suspend business, or shall file a voluntary petition or an answer admitting the jurisdiction of the court and the material allegations of, or shall consent to, involuntary petition pursuant to or purporting to be pursuant to any reorganization or insolvency law of any jurisdiction, or shall make an assignment for the benefit of creditors, or shall apply for or consent to the appointment of a receiver or trustee of a substantial part of its property, to the extent permitted by law, this Agreement shall automatically terminate effective as of a date ten (10) days prior to LICENSEE's change of status hereunder and shall be subject to Article 3.3.

3.2 Effect of Termination. Upon termination of this Agreement, LICENSEE shall cease all production and sale of Licensed Products and Licensed Processes except for the production and sale of Licensed Product on which production had begun prior to notice of such termination. LICENSEE may continue to sell such Licensed Product for up to one year after such notice upon payment of royalties accruing thereon, and shall render an accounting to VANDERBILT of any royalties which may be due, and the sublicenses granted hereunder shall be assigned to VANDERBILT. Immediately upon termination all rights of Licensee, except as expressly stated in this article, shall revert to Vanderbilt.

3.3 Articles 3.2, 9.1, 9.2, 9.3, 9.4 and 10 of the Agreement shall survive termination.

3.4 If this Agreement is terminated under the provisions of Article 3.1, then Oxford Biomedical Research, Inc. shall have the first opportunity to negotiate an exclusive, royalty-bearing license to all intellectual property rights embodied in or derived from the VANDERBILT Invention and to VANDERBILT's rights embodied in or derived from the Joint Invention in the field of clinical diagnosis.

## **4 CONSULTING AGREEMENTS**

4.0 Consulting Agreements. In the event LICENSEE desires to have a consulting agreement with the Inventors, any such consulting agreement will be separate and apart from this Agreement, and in accord with VANDERBILT policy and procedures.

## **5 ROYALTIES AND MILESTONES**



5.0 Initial Payment. Upon execution of this Agreement, LICENSEE shall issue to VANDERBILT a number of shares of common stock which is equivalent to ten percent (10%) of the founders equity of LICENSEE, such shares to be subject to a separate Shareholder Agreement and any and all restrictions on transfer contained in the LICENSEE's charter, by-laws or an agreement to which VANDERBILT is a party.

5.1 Royalties. Commencing on the Effective Date of this Agreement, LICENSEE agrees to pay VANDERBILT at the rate of five (5%) percent of Net Sales of Licensed Products and Licensed Processes sold to third parties. Upon expiration of the last to expire of patents issued with respect to the Vanderbilt Invention (United States Patent Application Serial No. 08/304,147 and any divisions, continuations, extensions or reissues thereof, including United States Continuation-In-Part Patent Application Serial No. 08/912,440), the royalty rate for continued license of Technical Information will reduce to 2.0% of Net Sales of Licensed Products and Licensed Processes sold to third parties.

5.2 Schedule of Payment. LICENSEE further agrees to pay royalties and fees on a quarterly basis based on LICENSEE's fiscal quarter and payments shall be due within thirty (30) days after the completion of the fiscal quarter. Each such payment shall be accompanied by a statement for the period covered by such royalties showing total number or volume of Licensed Products or Licensed Processes sold, and total royalties and fees due, and identified as Net Sales within U.S. or non-U.S. This statement is to be certified as accurate by a responsible officer of LICENSEE.

5.3 Minimum Royalties. LICENSEE agrees to pay to VANDERBILT annual Minimum Royalties to maintain this License, commencing one year after first commercial sale of a Licensed Product or Licensed Process, according to the following schedule:

Years 2-3 following first commercial sale	\$ 5,000
Year 4 and beyond following first commercial sale	\$10,000

Minimum royalty payments shall also be credited against earned royalties and are payable at the beginning of each royalty year. Failure to pay Minimum Royalties may result in the termination of the license. In the event of termination, any minimum payments owed shall be pro-rated to the date of termination.

5.5 Sublicense Royalties. LICENSEE agrees to pay to VANDERBILT twenty percent (20%) of any fees resulting from sublicensing agreements. Such fees shall not include any research and development funded by sublicensee, as established by appropriate documents of sublicensee.

5.6 Reports. LICENSEE shall provide written annual reports within thirty (30) days after December 31 of each calendar year which shall include but not be limited to: reports of progress on research and development, regulatory approvals, manufacturing, sublicensing, marketing and sales during the preceding twelve (12) months as well as plans for the coming year. LICENSEE shall promptly notify VANDERBILT if any changes in the marketplace or in

LICENSEE's financial condition or business aims suggest commercialization will not occur within five (5) years from the date hereof.

5.7 Records. LICENSEE shall maintain complete and accurate records sufficient to enable accurate calculation of royalties due VANDERBILT under this Agreement. LICENSEE shall, at VANDERBILT's request and expense, provide certified statements from LICENSEE's auditors, concerning royalties due pursuant to this Agreement. Once a calendar year, VANDERBILT shall have the right to select a certified public accountant to inspect, on reasonable notice and during regular business hours, the records of LICENSEE to verify LICENSEE's statements and royalty payments due pursuant to this Agreement. The entire cost for such inspection shall be borne by VANDERBILT, unless there is a discrepancy of greater than 5% in VANDERBILT's favor, in which case LICENSEE shall bear the entire cost of the inspection. Records shall be preserved by LICENSEE for three (3) years for inspection by VANDERBILT.

5.8 If this Agreement is not terminated in accordance with other provisions hereof, LICENSEE's obligation to pay royalties hereunder shall continue for the life of the Licensed Patent Rights.

5.9 The royalty on sales in currencies other than U.S. Dollars shall be calculated using the appropriate exchange rate for such transactions quoted by CITICORP BANK (NEW YORK) foreign exchange desk on the last banking day of each calendar quarter. Royalty payments to VANDERBILT shall be in U.S. Dollars.

5.10 In the event that LICENSEE is acquired by a third party or enters into a joint venture with a third party, or in any other way transfers all of its assets, including this License to a third party, all obligations of this License, including the foregoing royalty terms, shall be binding upon the party acquiring this License.

## **6 PROSECUTION AND MAINTENANCE OF PATENT RIGHTS**

6.0 Upon execution of this License Agreement, LICENSEE agrees to pay for all costs incurred in the prosecution and maintenance of patents included in this Agreement. All past prosecution expenses paid by Vanderbilt shall be reimbursed to Vanderbilt within thirty (30) days of receipt of an invoice from Vanderbilt after the Effective Date of this Agreement.

6.1 LICENSEE shall have responsibility for prosecution and maintenance of patent applications and patents related to the Vanderbilt Invention and the Joint Invention, provided however that VANDERBILT shall have reasonable opportunities to advise LICENSEE and shall cooperate with LICENSEE as to the filing, prosecution and maintenance of such patent applications and patents. LICENSEE shall furnish to VANDERBILT copies of documents relevant to any such filing, prosecution or maintenance. LICENSEE shall be obligated to make timely payment of all maintenance fees following the issuance of the Patent. If LICENSEE elects to no longer prosecute or pay the expenses of a patent application or patent included

within the Licensed Patent Rights, LICENSEE shall notify VANDERBILT not less than sixty (60) days prior to such action, or deadline required to preserve Patent Rights, and shall thereby surrender its rights under such patent or patent application.

## **7 CONFIDENTIALITY**

7.0 It may be necessary for one party to disclose to the other party certain confidential or proprietary information. In such event, the receiving party agrees to preserve such identified information as confidential. The obligation of confidentiality in this paragraph shall apply to any and all information contained in any patent application or draft thereof provided by VANDERBILT to LICENSEE, including those applications confidentially provided to LICENSEE prior to the effective date of this Agreement. The obligation of confidentiality shall not apply to information which:

(a) is now in the public domain or which becomes generally available to the public through no fault of the receiving party; or

(b) is already known to, or in the possession of, the receiving party prior to disclosure by the disclosing party as can be demonstrated by documentary evidence; or

(c) is disclosed on a non-confidential basis from a third party having the right to make such a disclosure; or

(d) is independently developed by the receiving party (by activity not associated with the Licensed Technology) as can be demonstrated by documentary evidence.

7.1 Term The confidentiality obligations of this Article shall continue for a period of five (5) years beyond the termination of this Agreement.

## **8 INFRINGEMENT**

8.0 Third Party Infringement of Patent Rights. LICENSEE and VANDERBILT shall promptly provide written notice, to the other party, of any alleged infringement by a third party of the Patent Rights and provide such other party with any available evidence of such infringement. In the event there is good reason to believe infringement of any of the Licensed Patents is occurring, LICENSEE will take prompt action to abate or settle such infringement. LICENSEE shall have the right to institute an action in its own name, in so far as permitted by law, to abate the infringement and may join VANDERBILT as a party plaintiff, if without cost to VANDERBILT.

8.1 Enforcement and Defense. During the term of this Agreement, LICENSEE shall have the right, to prosecute and/or defend, at its own expense and utilizing counsel of its choice, any infringement of, and/or challenge to the Patent Rights. LICENSEE shall promptly provide

VANDERBILT copies of all litigation pleadings and other documents submitted to the court. No settlement, consent judgment or other voluntary final disposition of any such suit may be entered into without the written consent of VANDERBILT, which consent shall not unreasonably be withheld. LICENSEE shall indemnify VANDERBILT against any order for cost that may be made against VANDERBILT in any such suit.

8.2 Costs of Enforcement and Defense. In the event that LICENSEE shall undertake the enforcement and/or defense of the Patent Rights, as provided in Paragraph 8.1, LICENSEE may withhold up to fifty percent (50%) of the royalties of any calendar year, in the country in which such a suit is filed, otherwise thereafter due VANDERBILT and apply the same toward reimbursement of up to one half (½) LICENSEE's expenses relating to such suit or legal action, including attorneys' fees. In the event LICENSEE recovers from the infringer LICENSEE's legal fees and other expenses of litigation, it shall promptly reimburse Vanderbilt any retained royalties plus reasonable interest.

8.3 Control. If within six (6) months after receiving notice of any alleged infringement of the Patent Rights by a third party, LICENSEE shall have been unsuccessful in persuading the alleged infringer to desist, or shall not have brought and shall not be diligently prosecuting an infringement action, or if LICENSEE shall notify VANDERBILT, at any time prior thereto, of its intention not to bring suit against the alleged infringer, then VANDERBILT shall have the right, but not the obligation, to prosecute, at its own expense and utilizing counsel of its choice, any infringement of the Patent Rights, and VANDERBILT may, for such purposes, join the LICENSEE as a party plaintiff. The total cost of any such infringement action commenced solely by VANDERBILT shall be borne by VANDERBILT and VANDERBILT shall keep any recovery or damages for past infringement derived therefrom.

8.4 Cooperation. In any suit to enforce and/or defend the Patent Rights pursuant to this License Agreement, the party not in control of such suit shall, at the request and expense of the controlling party, cooperate in all respects and, to the extent reasonably possible, have its employees testify when requested and make available relevant records, papers, information, samples, specimens, and the like.

8.5 Damages. In the event LICENSEE institutes an action for infringement of Patent Rights in its own name under this Section 9 and a settlement is entered into or monetary damages are awarded in a final non-appealable judgment, the amount paid as a result of such settlement or the monetary damages awarded shall first be applied to the payment of LICENSEE's attorney's fees incurred in bringing the action and next toward reimbursement of VANDERBILT for any royalties past due or withheld with the terms of this Section 9, plus reasonable interest, the balance, if any, shall be divided equally between VANDERBILT and LICENSEE.

8.6 Licensed Patents Infringing Third Parties. Each party shall promptly notify the other if any legal proceedings are commenced or threatened against either party or any purchaser of a Licensed Product sold by LICENSEE on the ground that the manufacture, use, sale or possession of the Licensed Product is an infringement of a third party's patent or other intellectual property rights. LICENSEE shall, at its own expense, conduct all suits brought

against it as a result of the exercise of the rights granted hereunder, and VANDERBILT shall, at the request and expense of LICENSEE, give LICENSEE all reasonable assistance in any such proceedings. Payment of any amounts which may be recovered by such third party by way of judgment, award, decree, or settlement, that resulted from infringement of third party patent rights by a licensed Product, including attorneys fees and other costs, shall be the sole responsibility of LICENSEE. LICENSEE agrees not to settle or compromise any action, suit or proceeding without prior written consent of VANDERBILT, which consent shall not unreasonably be withheld.

## **9 WARRANTIES AND INDEMNITIES**

9.0 Nothing in this Agreement shall be construed as:

- (a) a warranty or representation by VANDERBILT as to the validity or scope of a Licensed Patent;
- (b) a warranty or representation by VANDERBILT that anything made, used, sold, or otherwise disposed of through the license granted herein is or will be free from infringement of patents, copyrights, trademarks, or other proprietary rights of third parties;
- (c) an obligation by VANDERBILT to bring or prosecute actions or suits against third parties for infringement;
- (d) Granting by implication, estoppel, or otherwise any licenses under patents of VANDERBILT or other persons other than Licensed Patent Rights, regardless of whether such Patents are dominant or subordinate to any Licensed Patent Rights.

9.1 (a) LICENSEE shall indemnify, defend and hold harmless VANDERBILT and its trustees, officers, faculty, staff, employees, students, agents and representatives, and their respective successors, heirs and assigns (the "Indemnitees"), against any liability, damage, loss or expenses (including reasonable attorney's fees and expense of litigation) incurred by or imposed upon the Indemnitees or any one of them in connection with any claims, suits, actions, demands or judgments arising out of any theory of law (including, but not limited to, actions in the form of tort, warranty, or strict liability) concerning any product, process or service made, used or sold pursuant to any right or license granted under this Agreement. Such indemnity obligation shall include claims and expenses related to infringement of a third party's rights by the Licensed Product.

(b) LICENSEE agrees, at its own expense, to provide attorneys reasonably acceptable to VANDERBILT to defend against any actions brought or filed against any party indemnified hereunder with respect to the subject of indemnity contained herein, whether or not such actions are rightfully brought.

9.2 VANDERBILT MAKES NO REPRESENTATIONS AND EXTENDS NO

WARRANTIES OF ANY KIND EXPRESS OR IMPLIED. THERE ARE NO EXPRESS OR IMPLIED WARRANTIES OF MERCHANTABILITY OR FITNESS FOR A PARTICULAR PURPOSE, OR THAT USE OF A LICENSED PRODUCT WILL NOT INFRINGE ANY PATENT, COPYRIGHT, TRADEMARK, OR OTHER RIGHTS OF THIRD PARTIES.

9.3 Regarding the indemnity and hold harmless provisions, under Paragraph 9.1, VANDERBILT shall give prompt written notice to LICENSEE of the commencement of any action, suit, or proceeding for which indemnification may be sought, and LICENSEE, through counsel reasonably satisfactory to VANDERBILT shall assume the defense thereof; provided, however, that VANDERBILT shall be entitled to participate in any such action, suit, or proceeding with counsel of its own choice, but at its own expense. If LICENSEE fails to assume the defense within a reasonable time, VANDERBILT may assume such defense and the reasonable fees and expenses of its attorneys will be covered by the indemnity provided for in Paragraph 9.1. No such action, suit, or proceeding shall be compromised or settled in any manner without the prior written consent of VANDERBILT. Notwithstanding anything in this Paragraph to the contrary, LICENSEE shall not, without the written consent of VANDERBILT, which consent shall not be unreasonably withheld:

(a) Settle or compromise any action, suit, or proceeding or consent to the entry of any judgment which does not include as an unconditional term thereof the delivery by the claimant or plaintiff to VANDERBILT of a written release from all liability in respect of such action, suit, or proceeding; or

(b) Settle or compromise any action, suit, or proceeding in any manner which may materially and adversely affect VANDERBILT.

9.4 Insurance. (a) Beginning at the time as any Licensed Product is being commercially distributed or sold by LICENSEE or by a sublicensee, or agent of LICENSEE, LICENSEE or such other, shall procure and maintain comprehensive general product liability and tort liability insurance in amounts not less than \$5,000,000 per incident and \$5,000,000 annual aggregate and name the Indemnitees as additional insureds. Such comprehensive general liability insurance shall provide (i) product liability coverage and (ii) broad form contractual liability coverage for LICENSEE's indemnification under this Agreement. If LICENSEE elects to self-insure all or part of the limits described above, such self-insurance program must be reasonably acceptable to VANDERBILT. LICENSEE agrees that no amount greater than the sum of \$250,000 shall be deductible under LICENSEE's primary coverage for VANDERBILT and LICENSEE against any claims or suits arising from alleged defects in Licensed Products. The minimum amounts of insurance coverage required shall not be construed to create or limit LICENSEE's liability with respect to its indemnification under this Agreement.

(b) LICENSEE represents and warrants that its product liability and general tort liability is of the occurrence-based rather than claims-made type. Within thirty (30) day after the date of the first commercial sale of a Licensed Product hereunder, LICENSEE shall provide VANDERBILT with a certificate or certificates of insurance evidencing that VANDERBILT has been named as an additional insured party and evidencing the insurer(s) is required to notify

VANDERBILT in writing at least thirty (30) days in advance of any termination of the policy or certificate, or any modification that would cause LICENSEE no longer to be in compliance with the provisions of this Article, or would cause the representation and warranties set forth above in this Article no longer to be true, such written notification to specify the reason for such termination, the nature of the proposed modification, as the case may be. It is expressly agreed by the parties that the provisions of this Article regarding insurance shall in no way limit LICENSEE's indemnity obligations, except to the extent that LICENSEE's insurer (s) actually pays VANDERBILT amounts for which VANDERBILT is entitled to be indemnified under this Agreement, nor shall VANDERBILT have any obligation to pursue any insurer as a precondition to its rights to be indemnified by LICENSEE. As used in this Article, the term "VANDERBILT" shall include VANDERBILT, and its officers, directors, agents and employees. If LICENSEE does not obtain replacement insurance within such thirty (30) day period specified above, VANDERBILT shall have the right to terminate this Agreement effective at the end of such thirty (30) day period without notice or any additional waiting periods.

(c) LICENSEE shall maintain such comprehensive general product liability and tort liability insurance or self-insurance beyond the expiration or termination of this Agreement during (i) the period that any product relating to, or developed pursuant to, this Agreement is being commercially distributed or sold by LICENSEE or by a sublicensee or agent of LICENSEE and (ii) a period not less than the statute of limitations for product liability claims in the state in which the product is being used.

## **10 USE OF VANDERBILT'S NAME**

10.0 LICENSEE agrees not to identify VANDERBILT or to use the name of VANDERBILT, its faculty, employees, or students, or any trademark, service mark, trade name, or symbol of VANDERBILT, or that is associated with any of them, in promotional advertising or other similar materials without VANDERBILT's written consent, except as required by governmental authority. LICENSEE may, without prior consent, refer to VANDERBILT as LICENSOR of Licensed Product in a business plan, fund raising material or the like. Other uses of VANDERBILT's name shall be made only after prior approval.

10.1 VANDERBILT agrees not to identify LICENSEE or to use the name of LICENSEE's officers, employees, or any trademark, service mark, trade name or symbol of LICENSEE without the written consent of LICENSEE, except as may be required by governmental authority.

## **11 TERMS AND CONDITIONS**

11.0 Manner of Payment. All payments hereunder shall be made by check to VANDERBILT. Where required to do so by applicable law or treaty, LICENSEE shall withhold taxes required to be paid to a taxing authority on account of such income to VANDERBILT, and LICENSEE shall furnish VANDERBILT with satisfactory evidence of

such withholding and payment in order to permit VANDERBILT to obtain a tax credit or other relief as may be available under the applicable law or treaty.

11.1 Provisions Contrary to Law. In performing this Agreement, the parties shall comply with all applicable laws and regulations. In particular, it is understood and acknowledged that the transfer of certain commodities and technical data is subject to United States laws and regulations controlling the export of such commodities and technical data, including all Export Administration Regulations of the United States Department of Commerce. These laws and regulations among other things, prohibit or require a license for the export of certain types of technical data to certain specified countries. LICENSEE hereby agrees and gives written assurance that it will comply with all United States laws and regulations controlling the export of commodities and technical data, that it will be solely responsible for any violation of such by LICENSEE or its Affiliates or sublicensees, and that it will defend and hold VANDERBILT harmless in the event of any legal action of any nature occasioned by such violation.

Nothing in this Agreement shall be construed so as to require the violation of any law, and wherever there is any conflict between any provision of this Agreement and any law the law shall prevail, but in such event the affected provision of this Agreement shall be affected only to the extent necessary to bring it within the applicable law.

11.2 Notices. Any notice may be initially given by facsimile with confirmation required or permitted to be given by this License by postpaid, first class, registered or certified mail addressed as set forth below unless changed by notice so given:

For LICENSEE:

Eric Kuhrts  
President/CEO *Diagnostics Ent*  
LIPOPROTEIN ~~Technologies~~, Inc.  
256 Grandview Dr.  
Redwood City, CA 94062  
fax: ~~415~~-851-5709  
*650*

For VANDERBILT:

Larry R. Steranka  
Office of Technology Transfer  
VANDERBILT University  
110 21st Avenue South, Suite 850  
Nashville, TN 37203  
fax: 615-343-1145

Such notice shall be effective upon receipt by the party to whom notice is sent.

11.3 Dispute Resolution. The parties acknowledge and agree that they have entered into this Agreement with the expectation of a long-term, mutually beneficial relationship. However, should disagreement arise regarding obligations imposed on the parties by this Agreement, it is agreed that the parties will, in good faith, promptly attempt to reach an amicable resolution of such disagreement.

11.4 Force Majeure. Neither party to this License Agreement shall be liable for delay or failure in the performance of any of its obligations hereunder if such delay or failure is due to causes beyond its reasonable control, including, without limitation, acts of God, fires, earthquakes, strikes and labor disputes, acts of war, civil unrest, or intervention of any governmental authority, but any such delay or failure shall be remedied by such party as soon as



is reasonably possible. Failure to make timely royalty payments shall not be excused by Force Majeure.

11.5 Assignments. This Agreement may not be assigned by either party without the written prior consent of the other party, which consent shall not be unreasonably withheld. The parties hereto agree that each is acting as an independent contractor and not as an agent of the other or as joint venturers.

11.6 Waivers and Modifications. The failure of any party to insist on the performance of any obligation hereunder shall not act as a waiver of such obligation. No waiver, modification, release, or amendment of any obligation under this Agreement shall be valid or effective unless in writing and signed by both parties hereto.

11.7 Successors in Interest. This Agreement shall inure to the benefit of and be binding on the parties' permitted assigns, successors in interest, and subsidiaries.

11.8 Choice of Law and Jurisdiction. This Agreement is subject to and shall be construed and enforced in accordance with the laws of the U.S.A, and Tennessee. Any action on any dispute arising out of this Agreement shall be tried in Davidson County, and the parties consent to the jurisdiction of the state and federal courts there.

11.9 Entire Agreement. This Agreement constitutes the entire agreement between the parties as to the subject matter hereof, and all prior negotiations, representations, agreements and understandings are merged into, extinguished by and completely expressed by this Agreement.

IN WITNESS WHEREOF, the parties have duly executed this Agreement on the date(s) written below.

VANDERBILT UNIVERSITY

By:

Harry R. Jacobson  
Harry R. Jacobson, M.D.  
Vice Chancellor for  
Health Affairs

Date:

\_\_\_\_\_

By:

Larry R. Steranka  
Larry R. Steranka, Ph.D.  
Director  
Office of Technology Transfer

Date:

May 5, 1998

LIPOPROTEIN DIAGNOSTICS, INC.

By:

Eric Kuhrt  
Eric Kuhrt  
President/CEO

Date:

5/15/98

ACKNOWLEDGED AND AGREED:

By:

L. Jackson Roberts II  
L. Jackson Roberts II, M.D.  
Professor of Pharmacology & Medicine

Date:

May 11, 1998

By:

Jason D. Morrow  
Jason D. Morrow, M.D.  
Associate Professor of Pharmacology & Medicine

Date:

5/11/98

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**Patent Number: 5700654**

**Application Number: 08304147**

	<b>4th Year</b>	<b>8th Year</b>	<b>12th Year</b>
<b>Open Date</b>	12/26/2000	12/23/2004	12/23/2008
<b>Surcharge Date</b>	06/26/2001	06/24/2005	06/24/2009
<b>Close Date</b>	12/26/2001	12/23/2005	12/23/2009

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METHOD AND COMPOSITIONS TO ASSESS OXIDATIVE S

Application Data	Transaction History	Continuity Data	Published Documents	Fees	Address & Attorney/Agent
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#### Correspondence Address

Name:	KENNETH I. KOHN
Address:	KOHN & ASSOCIATES 30500 NORTHWESTERN HWY., SUITE 410 FARMINGTON HILLS, MI 48334

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30955	KOHN, KENNETH
31338	CHOW, STEPHEN
31405	PAUL, EDWIN
37504	SHEA, TIMOTHY
38972	MONTGOMERY, ILENE

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08/304,147 METHOD AND COMPOSITIONS TO ASSESS OXIDATIVE S

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Application Number:	08/304,147				Customer Number:
Filing or 371 (c) Date:	09-12-1994				Status:
Application Type:	Utility				Status Date:
Examiner Name:	MOHAMED, ABDEL A				Location:
Group Art Unit:	1654				Location Date:
Confirmation Number:	9135				Earliest Publication
Attorney Docket Number:	9101BCIP				Earliest Publication
Class / Subclass:	435/025				Patent Number:
First Named Inventor:	L. JACKSON ROBERTS , NASHVILLE, TN (US)				Issue Date of Pater
Title of Invention:	METHOD AND COMPOSITIONS TO ASSESS O				

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Application Data	Transaction History	Continuity Data	Published Documents	Fees	Address & Attorney/Agent
Application Number:		08/304,147			Customer Number:
Filing or 371 (c) Date:		09-12-1994			Status:
Application Type:		Utility			Status Date:
Examiner Name:		MOHAMED, ABDEL A			Location:
Group Art Unit:		1654			Location Date:
Confirmation Number:		9135			Earliest Publication
Attorney Docket Number:		9101BCIP			Earliest Publication
Class / Subclass:		435/025			Patent Number:
First Named Inventor:		L. JACKSON ROBERTS , NASHVILLE, TN (US)			Issue Date of Pater
Title of Invention:		METHOD AND COMPOSITIONS TO ASSESS O			

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